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REMARKS / DISCUSSION OF ISSUES

Claims 1 – 14 and 16 – 21 are pending in the application. Claims 1, 14 and 17 are independent.

In the present amendment, claims 1, 14 and 17 are amended. No new matter is added.

35 U.S.C. 101

Under 35 U.S.C. 101, the Office Action rejects claims 1, 4 and 17.

Applicants submit that the steps recited in the amended claims are tied to a statutory class of invention. For example, claim 1, in part, recites:

"*receiving an input in the recommender system from one or more sources*," and

"*generating and outputting recommendation at the processing device in accordance with the search criteria, based at least in part on the processed input*."

Therefore, in the claimed invention, the input is transformed into output recommendation at the processing device. Applicants submit that the results are tangible and physically tied to the processing device. Thus, claim 1 is clearly directed to statutory subject matter. Similarly claims 14 and 17 are also directed to statutory subject matter, because claim 14 recites a processor being operative to process offers from one or more sources and to generate and output the recommendation in accordance with the search criteria, based at least in part on the input; and claim 17 recites receiving an input in a recommender system and generating and outputting recommendation at the processing device based on the processed input.

In view of at least the foregoing, Applicants submit that claims 1, 14 and 17 are directed to statutory subject matter. Withdrawal of the rejection of claims 1, 14 and 17 under 35 U.S.C. 101 is respectfully requested.

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35 U.S.C. 112

Under 35 U.S.C. 112, second paragraph, the Office Action rejects claims 1, 14 and 17, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office Action alleged that the term "user-selectable limiting factors" in claims 1 and 14 is used by the claims to mean "factors that are independent of the search criteria", and that the term is indefinite because the specification does not clearly redefine the term.

Applicants submit that although the specification does not explicitly redefine the "user-selectable limiting factors" further as "factors that are independent of the search criteria", the specification clearly indicates that the user-selectable limiting factors are independent of the search criteria. For example, Applicants' specification, page 10, lines 16 – 26, recites:

"*Limiting factors selected by a given user can be stored as part of a corresponding user profile for utilization in generating particular types of recommendations. For example, a user may prefer relatively quick recommendations when it comes to offers involving particular types of goods or services or offers received in particular situations, but may prefer that the system generate a higher quality recommendation for offers involving other types of goods and services or offers received in other situations. Once a user has selected a given type of limiting factor for use with a particular offer or situation, that selected factor may be stored as part of the user profile.*"

For the above, it is clear that the limiting factors can be freely applied in various situations involving various types of goods and services. Therefore, for the same type of goods or services, different limiting factors may be applied depending on the user's selection in the particular situation. Since the types of goods and services are defined by the search criteria, the limiting factors must be independent of the search criteria because the limiting factors must be able to apply to various situations involving same or different types of goods and services. If the limiting factors were dependent on a search criterion, then the system would not be able to

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generate different types of recommendations based on the same search criterion, because the same search criterion would necessarily fix the limiting factors that can be used.

Therefore, the claimed feature that the limiting factors are independent of the search criteria is fully supported by the specification. Thus, the term "user-selectable limiting factors" in claims 1 and 14 is definite because the claim language clearly indicates that these factors are independent of the search criteria.

Applicants submit that amended claims 1, 14 and 17 are definite. No new matter is added. Withdrawal of the rejection of claims 1, 14 and 17 under 35 U.S.C. 112, second paragraph, is respectfully requested.

35 U.S.C. 102

Under 35 U.S.C. 102(a), the Office Action rejects claims 1 – 3, 5, 8 – 10, 12 – 14, 16, 17, 20 and 21 as being anticipated by the LexisNexis website printouts, hereinafter Lexis.

In the Office Action, page 14, the Office conceded that some of the factors disclosed in Lexis such as KWIC search, etc. are limiting the results after the results have already been processed. However, the Office Action also alleged that the Jurisdiction selection in Lexis is a factor that limits optimal processing characteristics of a recommendation generating process. Applicants respectfully disagree.

Applicants' claim 1, in part, requires:

"*pre-defining one or more user-selectable limiting factors in a recommender system that limit optimal processing characteristics of a recommendation-generating process implemented in the recommender system and that are independent of the search criteria.*" (Emphasis added)

Applicants submit that the Jurisdiction selection in Lexis is just a search criterion, because the Jurisdiction selection specifies which databases to be used (e.g., a criterion whether it is binding or persuasive) and therefore, such database selection is just one of the search criteria selected by the user, but not a limiting factor that is independent of the search criteria. Although a Jurisdiction selection

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search with a wider scope would require accessing a larger number of databases than a search with narrower scope, there is no fundamental difference between other search criteria where, for example, a broader keyword search which may require accessing a larger number of databases than a specific keyword search. Clearly, the Jurisdiction selection is an input that is dependent on the search criteria. Having the Jurisdiction selection, the optimal processing in Lexis simply implies the optimal search criteria, not the optimal processing as limited by the pre-defined one or more user-selectable limiting factors. Therefore, Applicants submit that the Jurisdiction selection in Lexis is not the one or more pre-defined, user-selectable limiting factors <u>that are independent of the search criteria</u>, as claimed.

In view of at least the foregoing, Applicants submit that claim 1 is patentable over Lexis.

Independent claim 14 similarly requires:

"*one or more limiting factors in an implementation of a recommender system <u>that are independent of the search criteria</u>.*" (Emphasis added)

Also, independent claim 17 requires:

"*pre-defining one or more user-selectable limiting factors in a recommender system that limit optimal processing characteristics of a recommendation-generating process implemented in the recommender system and <u>that are independent of the search criteria</u>.*" (Emphasis added)

Applicants essentially repeat the above arguments for claim 1, and apply them to claim 14 and 17, pointing out why Lexis fails to disclose that the limiting factors are independent of the search criteria, as claimed. Therefore, claims 14 and 17 are patentable over Lexis.

Claims 2, 3, 5, 8 – 10, 12, 13, 16, 20 and 21 are patentable because at least they respectively depend from claims 1, 14 and 17, with each claim containing further distinguishing features.

Withdrawal of the rejection of claims 1 – 3, 5, 8 – 10, 12 – 14, 16, 17, 20 and 21 under 35 U.S.C. 102(a) is respectfully requested.

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35 U.S.C. 103

Under 35 U.S.C. 103(a), the Office Action rejects claims 6, 7, 18 and 19 over Lexis in view of Shaw ("Inventing the 'Paper' of Figure…Newspapers and the Future: First of Two Part. Next: Fax, phones, fear and the future." <u>Los Angeles Times</u>. June 2, 1991. Pages 1 – 8, hereinafter Shaw); and claims 4 and 11 over Lexis in view of Official Notice.

Applicants submit that neither Shaw nor Official Notice can cure the defects present in Lexis as discussed above. Therefore, claims 1 and 17 are patentable over Lexis, Shaw and Official Notice, either singly or in combination. Claims 4, 6, 7, 11, 18 and 19 are patentable because at least they respectively depend from claims 1 and 17, with each claim containing further distinguishing features.

Withdrawal of the rejection of claims 4, 6, 7, 11, 18 and 19 under 35 U.S.C. 103(a) is respectfully requested.

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Conclusion

In view of the foregoing, Applicants respectfully request that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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